

REMARKS

The Office Action dated November 3, 2004 and the references cited therein have been carefully considered. In response, Applicants offers the following remarks and respectfully requests reconsideration and withdrawal of the rejections identified below.

Claims 48-82 are pending and at issue in this application. Of these, claims 48, 58 and 66 are independent.

Applicants respectfully traverse the rejection of claims 48, 58 and 66 as obvious over U.K. Patent Application No. GB 2,262,642 ("Claypole") in view of Gura et al. (U.S. Patent No. 6,270,411).¹ Applicants further respectfully traverse claims 49-57, 59-65 and 67-82 as obvious over Claypole and Gura et al. in further view of any combination of Luciano, Jr. et al. (U.S. Patent No. 6,050,895), Adamczyk et al. (U.S. Patent No. 6,379,250) and U.K. Patent Application No. GB 2,147,773 ("Dickinson").

Applicants respectfully submit that claims 48, 58 and 66 are not obvious over Claypole in view of Gura et al. The action does not make out a *prima facie* case of obviousness. Neither Claypole nor Gura et al. teaches or suggests all of the limitations of independent claims 48, 58 and 66. In particular, each of claims 48, 58 and 66 now recites a gaming apparatus for, or a gaming method of allowing a player to operate a second input device to play an aspect of a bonus game in a display region if there are at least three related symbols displaying common subject matter in display regions that are contiguous and that relate to the aspect of the bonus game. Neither Claypole nor Gura et al. teaches or suggests allowing a player to operate a second input device to play an aspect of a bonus game if there are at least three related symbols displaying common subject matter that are contiguous and that relate to the aspect of the bonus game. Therefore, claims 48, 58, and 66, and claims 49-57, 59-65, or 67-82, which depend therefrom, are not obvious over Claypole or Gura et al, either alone or in combination.

At issue is the triggering condition for the bonus game. The method and device of the pending claims recites a trigger based on at least three related symbols displaying common

¹ Page 2 of the Office Action states that "[c]laims 48, 58, 66 and 74-83 [are] rejected under 35 U.S.C. as being anticipated". Applicants believe the Office Action meant to state that the claims were obvious under 35 U.S.C. 103, not anticipated under 35 U.S.C. 102 as there is no one single reference that discloses all the elements of the pending claims.

subject matter that are contiguous and that relate to an aspect of the bonus game. Neither Claypole nor Gura et al. teaches or suggests the triggering condition recited in the pending claims.

Claypole uses a trail system to trigger the bonus game. (Page 3, ll. 17-20). Claypole discloses that its trail system comprises trail value numbers associated with a minority of fruit game symbols. (Page 11, ln. 24 to page 12, ln. 4). Claypole also discloses that the trail system triggers a bonus game only when a minimum threshold value is met or exceeded by adding the trail value numbers displayed along the win line for each play of the fruit machine. (Page 12, ll. 5-12). However, the bonus game is triggered regardless of the relationship or subject matter of the symbols being displayed. In other words, the triggering event in Claypole is based only on the added value of the trail numbers, and is not based on common subject matter of symbols displayed in contiguous display regions. As such, Claypole does not teach or suggest the triggering condition recited by the pending claims.

Gura et al. uses particular symbols to trigger the bonus game (“BOWLING ROLL”), such as a “bruiser”, a “lady” or a “wimpy guy”. The bonus game is triggered whenever the symbols appear anywhere on noncontiguous, alternating reels. (Col. 10, ln. 56 to col. 11, ln. 3; Figs. 9 and 10). In other words, the display regions of the triggering symbols are not contiguous. For example, as seen best in Fig. 9 of Gura et al., the symbol of the “wimpy guy” appears only on noncontiguous, alternating reels 130, 135, 138. (See also, col. 10, ll. 56-59). The display regions of the triggering symbols are never contiguous. As such, Gura et al. does not teach or suggest the triggering condition recited by the pending claims.

The rejections of claims 48, 58, and 66, and claims 49-57, 59-65, or 67-82, which depend therefrom, are therefore improper for failing to cite references that teach or suggest all of the claims limitations of independent claims 48, 58 and 66, whether taken individually or in combination. It is clear that a *prima facie* case of obviousness cannot be established where all the limitations of a claimed combination are not taught or suggested by the prior art. See *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). See also MPEP 2143.03.

It is further submitted that the action does not establish a *prima facie* case of obviousness because the references teach away from the combination of Claypole in view of Gura et al. In particular, Gura et al. teaches away from the triggering condition of Claypole. As discussed above, Claypole discloses triggering a bonus game triggering based on the

combined value of numbers associated with select symbols rather than the occurrence of particular symbols. Gura et al., on the other hand, discloses triggering a bonus game based on the occurrence of particular symbols in non-contiguous display regions rather than their combined value. One of ordinary skill in the art would therefore not be motivated to use the occurrence of particular symbols as disclosed by Gura et al. and an event trail as disclosed by Claypole in the same gaming apparatus because Gura et al. and Claypole teach two different bonus game triggering conditions. Therefore, Claypole and Gura et al. cannot be properly combined to disclose allowing a player to operate a second input device to play an aspect of a bonus game in a display region if there are at least three related symbols displaying common subject matter in display regions that are contiguous and that relate to the aspect of the bonus game, as recited in claims 48-82.

The rejections of claims 48, 58 and 66, and claims 49-57, 59-65, or 67-82 dependent thereon are therefore improper because the references teach away from each other, and cannot be combined. A *prima facie* case of obviousness cannot be established where the references teach away from their combination. See MPEP 2145(X)(D)(2).

CONCLUSION

Accordingly, Applicants respectfully submit that all pending claims are patentable over the art of record and should be allowed. In light of the foregoing, the prompt issuance of a notice of allowance is respectfully solicited.

Should the examiner have any questions, the examiner is respectfully invited to telephone the undersigned

Respectfully submitted,

MARSHALL, GERSTEIN & BORUN LLP
233 S. Wacker Drive
6300 Sears Tower
Chicago, Illinois 60606-6357
(312) 474-6300

By: _____

Aaron M. Peters
Registration No.: 48,801
Attorney for Applicants

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